

changed versions of documents in said document representation storage based on said user's indication of significance," the claimed system also stores "a predetermined number of most recently changed versions of documents irrespective of said document change monitoring element's and user's indication of significance."

Thus, the features of claim 1 do not contradict and claim 1 is definite. Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 1-3, 6, 8, 11-13 and 17 under 35 U.S.C. §103(a) over EP 1050831 (hereinafter "EP '831") in view of U.S. Patent No. 5,809,176 to Kish et al. (hereinafter "Kish"). Applicants respectfully traverse the rejection.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three criteria must be met (MPEP §§ 2142, 2143): 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings. 2) There must be a reasonable expectation of success. 3) The prior art reference (or references when combined) must teach or suggest all of the claim limitations. The first two criteria must both be found in the prior art, and not based on Applicant's disclosure (Id.).

On March 22, 2006 the Federal Circuit emphasized the importance of the first criterion when making a §103(a) rejection. *In re Kahn*, Appeal No. 04-1616 (Fed. Cir. March 22, 2006). Applicants respectfully submit that the Office Action fails to satisfy at least this first criterion.

In particular, the Office Action proposes that it "would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the teaching of Kish into the invention of [EP '831] by allowing the system to store changed versions of documents irrespective of the user's indication of significance in order to allow the system to store documents that a user may overlook and thus will give the user a diverse storage space"

(Office Action, p. 4). The Office Action fails to allege that this proposed motivation may be found in either of EP '831 or Kish. The Office Action also fails to allege that such a modification of EP '831 would be within the knowledge generally available to the skilled artisan.¹

Because the Office Action has failed to provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify EP '831, the Office Action has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Accordingly, the rejection is improper. Applicants respectfully request withdrawal of the rejection.

Furthermore, Applicants respectfully assert that no motivation to modify EP '831 based on the alleged teaching of Kish may be found in Kish. In particular, the portion of Kish relied on by the Office Action (C1/L63 - C2/L3) as allegedly teaching "storing copies for a predetermined number of the latest document versions," goes on to explain that such a feature is undesirable and disadvantageous. Specifically, that portion of Kish discloses that, when storing copies for a predetermined number of the latest document versions, "it is frequently not possible to keep a record of document changes since not all version of the document are simultaneously available" and, "since all changes are not available, some changes cannot be undone and redone." Thus, Kish explicitly teaches away from storing copies for a predetermined number of the latest document versions.

MPEP §2145(X)(D)(2) states that "it is impermissible to combine references where the references teach away from the combination." As Kish clearly teaches that it is undesirable and disadvantageous to store copies for a predetermined number of the latest

¹ See MPEP §2144.03 stating that reliance on the skill in the art as motivation for modifying or combining a reference requires official notice of the level of skill in the art or adequate evidence of the level of skill in the art.

document versions, Kish teaches away from modifying any other reference, such as EP '831, to include such a feature. Accordingly, in addition to the Office Action's failure to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the combined references teach away from the combination alleged by the Office Action in violation of MPEP §2145(X)(D)(2). For this additional reason, the rejection is improper and Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 4 and 5 under 35 U.S.C. §103(a) over the above combination of EP '831 and Kish in view of EP 1111517, and rejects claims 7, 9, 10, and 16 under 35 U.S.C. §103(a) over the above combination of EP '831 and Kish in view of Applicants' alleged admission of prior art. Applicants respectfully traverse the rejections.

These rejections are premised upon the presumption that the above combination of EP '831 and Kish discloses, teaches, or suggests all of the features of claims 1 and 11. Because, as discussed above, the Office Action has failed to establish that the above combination of EP '831 and Kish discloses, teaches, or suggests all of the features of claims 1 and 11, the rejections are improper. Applicants respectfully request withdrawal of the rejections.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1-17.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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